IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF APPEALS AND INTERFERENCES

Application of Mikhail Lotvin and Richard M. Nemes

Serial Number: 10/790,895

Filed: 03/02/2004

Entitled: Methods and Systems for Electronic Transactions

Group/Art Unit: 3625

Examiner: Adam Levine

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APPEAL BRIEF

This is an appeal from the Final Rejection of the Examiner dated 12/11/08

finally rejecting claims 13-15, 33-35, 37, 38, 40, 41, 47-50 and 52-56 of the above

application. A notice of Appeal was filed 06/08/1009 with a petition for extension

of time and required fee.

The fee required for the filing of this brief in support of an appeal is $270.

Appellants properly claim small entity status. A check for $270 is enclosed

herewith.

A petition for extension of time (2 months) is filed concurrently herewith

along with another check for $245. Appellants properly claim small entity status.

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REAL PARTY IN INTEREST

Same as the inventors in the caption of this application: Mikhail Lotvin and

Richard M. Nemes

RELATED APPEALS AND INTERFERENCES

None

STATUS OF CLAIMS

Claims 13-15, 33-35, 37, 38, 40, 41, 47-50 and 52-56 are pending in this application, and are finally rejected. The final rejection of claims 13-15, 33-35, 37, 38, 40, 41, 47-50 and 52-56 is appealed herein. Claims 1-12, 16-32, 36, 39, 42 – 46, 51 have been canceled without prejudice.

STATUS OF AMENDMENTS

All the amendments have been entered by the Examiner. There are no outstanding un-entered amendments in this case.

SUMMARY OF CLAIMED SUBJECT MATTER

A. CLAIM 13 - INEPENDENT

One embodiment of the invention (see, e.g. claim 13) provides a computer-implemented method, which enables an end user to specify telephone service logic using an Internet browser. (See, e.g., page 29, line 27 – page 30 line 18; Figs. 17A and 17B). The service logic includes the specification of voice mail that provides different outgoing messages (i.e., voice mail messages) selected based on the time of an incoming call that triggered voice mail. (See, e.g., page 30 lines 23, 24). The information representing the specified service logic is electronically provided to at least one computer controlling telephone service. (See, e.g., page 31 lines 10-16; Figs. 17A and 17B) This information enables such computer(s) to provide customized service in accordance with the user-provided service logic. (See, e.g., page 31 lines 16-21, Fig. 17B)

B. CLAIM 33 - INEPENDENT

One embodiment of the invention (see, e.g. claim 33) provides a computer system, accessible over the Internet, with storage for information representing the telephone service logic (See, e.g., page 29, line 27 – page 30 line 18; Page 5 line 24; Figs. 17A and 17B). The service logic includes the specification for voice mail with different outgoing messages (i.e., voice mail messages) selected based on the time of an incoming call that triggered voice mail. (See, e.g., page 30 lines 23, 24). The system also includes software that facilitates electronically providing information representing the service logic to at least one computer controlling telephone service. (See, e.g., page 31 lines 10-16; Figs. 17A and 17B) The service

logic enables such computer to control telephone service in accordance with the service logic. (See, e.g., page 31 lines 16-21, Fig. 17B)

C. DEPENDENT CLAIMS

Presently, it is believed that, there are no means plus function and step plus function limitations in the independent claims or dependent claims argued separately.

For convenience (although this identification is not required), it should be noted that, for example, the paragraph at page 30 line 19 – page 31, line 9 includes information relevant to the subject matter of the dependent claim argued separately,.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Rejection of Claims 13-15, 33-35,37,38,40,41,47-50 and 52-56 under 35 USC 103(a) as being unpatentable over Shaffer et al US Patent No. 6,464,222 ("the '222 patent") in view of Shaffer et al.US Patent No. ("the '374 patent").

ARGUMENT

The Examiner's rejection of the pending claims should be reversed because the cited references do not establish the *prima facie* obviousness of the pending claims.

As the Board is well aware, "[T]he legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process." MPEP (8th ed.), §2142. " The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." Id.

To establish obviousness prior art should at least suggest all of the features of a claim since "'rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.' *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___ , 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval)." Id. "All words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." MPEP (8th ed.), § 2143.03.

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)" MPEP (8th ed.), § 2143.03

In the present case, the Examiner's attempt to establish the *prima facie* obviousness of the pending claims fails to meet all the requirements, as discussed in detail below.

Nothing in the argument below should be construed as acquiescence with Examiner's position or as an admission, even when it is not necessary to dispute certain points in the Office Action in order to establish patentability.

Unless otherwise specified, all the references to statements by the Examiner or to the Office Action relate to the Office Action mailed 12/11/08 finally rejecting the claims at issue.

A.   REJECTION OF CLAIMS 13-15, 33-35,37,38,40,41,47-50 AND 52-56 UNDER 35 USC 103(A) AS BEING UNPATENTABLE OVER THE '222 PATENT IN VIEW OF THE '374 PATENT.

Independent Claims 13 and 33

The independent claims 13 and 33 are limited to "telephone service logic comprising specification for at least voice mail with different outgoing messages selected based on time of an incoming call," which is specified (claim 13) and stored (claim 33).

The Examiner asserts that the '374 patent teaches different outgoing messages selected based on time of incoming call. Specifically, the Examiner cites the abstract; Figs 10, 12, and 15; column 3 lines 24-55; column 8 lines 13-25; and column 12 line 35 – column 13 line 4. The '374 patent, however, does not provide for voice mail with different outgoing messages (i.e., different voice mail

messages), but instead teaches *call forwarding* (also referred to as *call routing*) based on user's calendar. More specifically:

The Abstract explains that "A telecommunications system is provided whereby *call routing* may be based on a pre-programmed calendar of time-date associations." (Emphasis added).

Fig. 10 also relates to call forwarding: "Turning now to FIG. 10, a diagram of an exemplary user interface 1000 for a user to input *call forwarding* information according to the present invention is shown." Column 12 lines 11-13 (Emphasis added).

FIGS. 12A-12B relate to call forwarding as well: "Turning now to FIGS. 12A-12B, exemplary graphical user interfaces 1300 for setting *call forwarding* information via the Web browser of FIG. 10 are shown." Column 12 lines 50-52 (Emphasis added).

The same is true for FIG. 15, which addresses call forwarding. "Turning to FIG. 15, a flowchart 6000 illustrating one method for invoking the mobility feature from a calendar application, is shown." Column 14 lines 18-21. The "mobility feature" refers to call forwarding; see, e.g., "In a step 7006, the system determines whether or not mobility has been activated for the specific *destination*." Column 14 lines 38-40 (Emphasis added). See also the description of the mobility feature in connection with Fig 14 ("Thus, the user may add new *call forwarding* information, modify existing *call forwarding* information, or delete *call forwarding* information" Column 14 lines 4-8).

In column 3 lines 43-55 it is explained that "According to a further embodiment of the invention, a telecommunications system is provided whereby *call routing* may be based on a pre-programmed calendar of time-date

associations. Moreover, the *routing* may be selective, based on caller-identification information. In particular, when a call arrives at a messaging server, such as a PBX or TOL server, a LAN database is checked. The LAN database points to a calendar corresponding to the user. *The calendar is queried to determine the user's location. The caller ID information is checked to determine whether the caller is authorized for forwarding. If so, the call is forwarded based on the calendar."* (Emphasis added). Clearly the cited section relates to call forwarding only.

Column 8 lines 13-25 relates to Fig 4 described as "FIG. 4 is a flowchart illustrating monitoring of time and location usage patterns" (Column 4 lines 1-2). The monitoring technology addressed in the cited portion has no relation to the subject matter of the present clams including voice mail with different messages.

Finally, the text in column 12 line 35 – column 13 line 4 clearly describes the *call forwarding* feature of the '374 patent. This description covers FIGS. 12A-12B that relate to call forwarding as described above and to Fig 11, which also relates to call forwarding (See, e.g., "Thus, the user can modify *call forwarding* information based on caller identification, time and calendar information via a Web browser." column 12 lines 35-37)

The above review of Examiner's references demonstrates that there is no suggestion in the cited art of the "telephone service logic comprising specification for at least *voice mail with different outgoing messages selected based on time of an incoming call*." No voice mail with messages selected based on the time of the incoming call is mentioned or suggested.

While the following is not argued in the Office Action, one may attempt to argue that, since both the claims at issue and the '374 patent relate to telecommunication and because the '374 patent describes routing calls to different

destinations based on a time period, the "voice mail with different outgoing messages selected based on time of an incoming call" would be obvious to a person skilled in the art. There is, however, no support for such an argument.

The '374 patent integrates user's calendar with call forwarding to facilitate user's ability to receive an incoming call at user's location, which is determined from the calendar. There is nothing in this functionality that may suggest voice mail with different messages. The fact that a time component is introduced in one application is not sufficient to preclude patentability of another application that employs a time variable, because, otherwise, the '374 patent would preclude patentability of any new time-based telecommunication application.

Furthermore, the '374 patent discloses a system which provides both call forwarding and voice mail capabilities. See, e.g., claim 9: "A system according to claim 1, including means for routing said telephone calls to a called party's voice mail." While the '374 patent talks about forwarding calls to different destinations based on time, no similar feature has been proposed or suggested in connection with voice mail discussed in the '374 patent. Thus, considering the art as a whole, the natural conclusion is that selecting different voice mail messages based on time of an incoming call is not obvious in view of the call forwarding of the'374 patent. The art itself fails to extend the time variable to voice mail while providing it for call forwarding.

The art that teaches adjusting call routing based on time and fails to provide any suggestion concerning varying voice mail based on time, while addressing voice mail in the same specification, cannot be construed in hindsight to suggest time-adjusted voice mail. By teaching time-based call forwarding and failing to

teach time—based voice mail, the cited art may be viewed as discouraging "voice mail with different outgoing messages selected based on time of an incoming call."

For the foregoing reasons, clams 13 and 33 and all the claims dependent therefrom are patentable.

Claim 37

Dependent claim 37 limits claim 13 to the telephone service logic further comprising "a specification for call waiting including a specification for which incoming calls the on-going call is to be interrupted." The Examiner cites Figs. 16, 19-20, column 3 lines 43-54, column 12 lines 10-30, column 15 lines 2-14, and column 16 lines 1-15 of the '374 patent as supporting "call waiting comprising specification of relative priorities of caller ID's." Page 5 of the Office Action. None of these citations, however, suggest anything related to call waiting; and, furthermore, they do not address selective call waiting based on the incoming call. Figs. 16, 19-20 relate to call transfer only. This is evident from concise descriptions of these figures at column 14, lines 33-51 (see, e.g., "Turning now to FIG. 16, a flowchart 7000 illustrating use of the mobility database to define the virtual location of the user is shown"), column 15 lines 40-59; and column15 line 60 – column 16 line 14. The flowcharts of these figures address call forwarding processes. (See, e.g., boxes 7016 of Fig. 16, 1310 of Fig. 19, 1410 of Fig. 20 confirming that these drawings are flowcharts of call forwarding steps).

The call forwarding system of the '374 patent may permit the user, who intends to travel to specify caller ID's for which the call should be transferred to such user's new location. So, as illustrated in Figs 19 and 20, for certain caller ID's the call is transferred to new user's location and for others it is sent to voice mail.

While the descriptions of Figs. 19 and 20 refer to interrupting the user, from

context, it is clear that the "interrupt" in the'347 patent relates to *call forwarding* for

certain caller ID's. In the'347 patent, to interrupt the user means to forward the call

the new destination so as to "interrupt" user's activity at the remote location; and

the referred to "interrupt" has nothing to do with anything related to call waiting.

This, for example, is clear from the following discussion at column 14 line 62 –

column 15 line 10:

> "In particular, in step 1102, the user may input the user's schedule, for
>
> example, using the interface shown in FIGS. 13A-B. In a step 1104, the
>
> scheduling software may access or display the phone number of the remote
>
> location to which the user may be moving, or alternatively, the user may
>
> input the telephone number or extension of the location, for example, via the
>
> window 1204. In a step 1106, the user sets whether or not the user may be
>
> interrupted at the remote location. Thus, for example, the user may set, as in
>
> window 1202, whether or not calls may be transferred. In a step 1108, the
>
> user may further input the identifies of parties to which or for which he may
>
> be interrupted, using, for example, the interface of FIG. 13B. As will be
>
> explained in greater detail below, caller-ID information may be used to filter
>
> or screen calls before transfers are permitted. Finally, in a step 1110, the
>
> calendar information with the call information may be uploaded to the TOL
>
> server 804 for access by the calendar interface program 916"

Thus, there is no doubt that to interrupt the user in the context of the '374 patent

means to transfer the call to the new location of the user.

Column 3 lines 43-54, cited by the Examiner, relate to call forwarding also with no application to call waiting, see, e.g., Col 3 lines 51-53 : "The caller ID information is checked to determine whether the caller is authorized for forwarding."

Column 12 lines 10-30 relate to call forwarding as well; see, e.g., "The user may direct call forwarding to occur based on caller-ID information, particular times, or a preset calendar." Col 12 lines 13-15

Column 15 lines 2-14 also relate to call forwarding and not cal waiting. For example, it is stated in this section: "As will be explained in greater detail below, caller-ID information may be used to filter or screen calls before transfers are permitted." Column 15, lines 6-8.

Column 16 lines 2-15 describe call forwarding and provide another explanation that the term "interrupt" in this reference refers to call forwarding with no application to call waiting:

"In a step 1414, caller identification information, if any, is checked. If the caller-ID information is provided, it is determined in a step 1416 whether or not the caller is authorized to interrupt at the changed location. If the caller is not authorized to interrupt the user at the remote location, then in a step 1424, the caller is sent to voice mail. If the caller is authorized to interrupt the user at the remote location, the caller may be given the option, in a step 1418, to interrupt the user. In a step 1422, the system determines whether the caller has executed the option. If the caller has instead chosen voice mail, then in a step 1424, the caller is sent to voice mail. Otherwise, the caller may be connected to the user in a step 1426."

Thus, the cited art provides no information concerning call waiting and it definitely does not suggest specifying for which incoming calls the on-going call is to be interrupted. For this additional reason claim 37 is patentable.

Claim 38

Dependent claim 38 dependents on claim 37 and recites that "the telephone service logic further comprising specification for blocking incoming calls based on caller ID." The Office Action does not cite any art against this limitation. While the '374 patent describes forwarding calls from only certain caller ID's, it does not suggest "blocking incoming calls based on caller ID."

Consequently, dependent claims 38 is patentable for this additional reason.

Claim 41

Dependent claim 41 adds to claim 40 (which depends on the independent claim 33) a limitation of "the telephone service logic further comprising specification for blocking incoming calls based on caller ID." The Office Action does not cite any art against this limitation. While the '374 patent describes forwarding calls from only certain caller ID's, it does not suggest "blocking incoming calls based on caller ID."

Consequently, dependent claims 41 is patentable for this additional reason.

Claims 47 and 53

Dependent claims 47 and 53 add a limitation that requires that the specification for voice mail comprises specifying different voice mail messages selected based on the incoming caller ID. Claims 47 is a dependent claim of the

independent claim 13 and claim 53 is a dependent claim of claim 40 that depends on the independent claim 33. As discussed above, in connection with claim 37, the cited art addresses providing call forwarding for selected caller IDs. It is, however, silent as to selecting different voice mail messages based on incoming caller ID despite the fact that the system of the '347 patent has voice mail. While the '374 patent includes both voice mail and call forwarding, it contains no suggestion of selecting voice mail messages based on caller IDs, thereby, discouraging the use of the limitations of these claims.

Consequently, dependent claims 47 and 53 are patentable for this additional reason.

Claim 55

Dependent claim 40 is a dependent claim of the independent claim 33. It adds a limitation of the telephone service logic further comprising specification for call waiting. Dependent claim 55 further limits claim 40 by adding that "the specification for call waiting comprises specification of relative priority of caller ID's, so as to determine, by comparing priority of caller ID of an incoming call with priority of caller ID of an on-going call, whether to provide a call waiting notification for the incoming call or direct the incoming call to voice mail." As discussed in connection with claim 37, the cited art does not deal with call waiting and does not suggest the use of caller ID's in connection with call waiting. While, the '374 patent describes that call forwarding may be permitted only for selected call ID's, it has no similar teaching in connection with call waiting. Further, even in connection with call forwarding, the '347 patent has no teaching of the relative priority of caller ID's as recited in claim 55. The '347 patent simply permits call forwarding only for

specific caller ID's. It does not suggest assigning priorities to caller ID's such that the comparison of theses priorities determines how to handle the incoming call.

Consequently dependant claim 55 is patentable for the above reason in addition to being dependent on patentable independent claims.

B. Claims not separately argued

Without conceding that they lack patentably distinguishing limitations, appellants acknowledge that, for purposes of this appeal, dependent claims not separately argued stand or fall with the separately-argued claim that they depend on.

CONCLUSION

As demonstrated above the rejected claims are patentable.

Appellants respectfully request that the Examiner's rejection of claims 13-15, 33-35, 37, 38, 40, 41, 47-50 and 52-56 be reversed.

Respectfully submitted,

October 6, 2009

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CLAIMS APPENDIX

13. A computer-implemented method comprising: using an Internet browser, enabling an end user to specify telephone service logic comprising specification for at least voice mail with different outgoing messages selected based on time of an incoming call; and electronically providing information representing the service logic to at least one computer controlling telephone service so as to enable the at least one computer controlling telephone service to control telephone service in accordance with the service logic.

14. The method of claim 13 wherein the at least one computer controlling telephone service is a telephone company computer.

15. The method of claim 13 wherein the at least one computer controlling telephone service is end users' local computer.

33. A computer system comprising: memory, accessible over the Internet, storing a telephone service logic comprising specification for at least voice mail with different outgoing messages selected based on time of an incoming call; and software electronically providing information representing the service logic to at least one computer controlling telephone service so as to enable the at least one computer controlling telephone service to control telephone service in accordance with the service logic.

34. The system of claim 33 wherein the at least one computer controlling telephone service is a telephone company computer.

35. The method of claim 33 wherein the at least one computer controlling telephone service is end users' local computer.

37. The method of claim 13 wherein the telephone service logic further comprises a specification for call waiting including a specification for which incoming calls the on-going call is to be interrupted.

38. The method of claim 37 wherein the telephone service logic further comprising specification for blocking incoming calls based on caller ID.

40. The system of claim 33 wherein the telephone service logic further comprising specification for call waiting.

41. The system of claim 40 wherein the telephone service logic further comprising specification for blocking incoming calls based on caller ID .

47. The method of claim 13 wherein the specification for voice mail comprises specifying different outgoing messages to be selected based on incoming caller ID.

48. The method of claim 13, wherein enabling an end user to specify telephone service logic includes enabling the end user to use voice input to specify the telephone service logic.

49. The method of claim 13, wherein enabling end user to specify telephone service logic includes enabling the end user to provide the service logic wirelessly from a portable device.

50. The method of claim 49 further comprising receiving data at the portable device based on a location of the portable device.

52. The method of claim 50, wherein the data, received at the portable device based on the location of the portable device, has been previously requested by the end user over the Internet.

53. The system of claim 40, wherein the specification for voice mail comprises specification of different outgoing messages to be selected based on incoming caller ID.

54. The system of claim 40 further includes voice recognition software enabling the end user to use voice input to specify telephone service logic.

55. The system of claim 40 wherein the specification for call waiting comprises specification of relative priority of caller ID's, so as to determine, by comparing priority of caller ID of an incoming call with priority of caller ID of an on-going call, whether to provide a call waiting notification for the incoming call or direct the incoming call to voice mail.

56. The method of claim 13 wherein the telephone service logic further comprises a specification for use of different carriers during different time periods.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.